

REMARKS

Claim 4 has been amended to correct a clerical error. The amendment does not constitute the addition of new matter to the specification. Applicant respectfully requests entry of the amendment and reconsideration of the application in view of the amendments and the following remarks.

Rejection of Claims 1, 2, 11, 16-18 and 22 Under 35 U.S.C. § 103

Claims 1, 2, 11, 16-18 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimasa et al. (EP 0 884 691 A2) in view of Hisatomi et al. (JP411232026). Applicant respectfully traverses this rejection.

The Examiner states "Contrary to applicant's arguments, Hisatomi et al discloses ribs with geometrical shape so that a user can perform blind touch operation. The ribs having a geometrical shape and the actual image being displayed on the screen would obviously take the same shape of the geometrical shape and that the function items are superposed on the image as claims." (Emphasis added.)

However, the Examiner's above assertions are not well grounded. Applicant submits herewith an English translation of Hisatomi (the specification and the figures) for the Examiner's reference.

Hisatomi states:

"A user moves a cursor by moving his/her finger on the touch-sensitive pointing device 208 on the rear surface while looking at image such as thumbnail images, icons and the like laid out and displayed on the image display 206, and selects an image." (para 15)

"Further, the images such as thumbnail images and icons are laid out and displayed as indicated by 701 in Fig. 7. The touch-sensitive pointing device 308 is controlled such that the cursor in the display screen on the front surface is moved in the direction of an arrow by moving the finger on the rear surface (702 in Fig. 7) in a direction of an arrow." (para 16) (Emphasis added.)

"Reference numeral 209 indicates a rib which is provided on the circumference of the pointing device 208 and guides the movements of the finger. By further providing the rib 209 on a concentric circle of the pointing device 208, the user can put his/her finger in rotary motion without looking at the rear surface while looking at the image information on the screen." (para 19) (Emphasis added.)

As is clear from the above, in Hisatomi, on the rear surface (702, Fig. 7), the rib (209, Fig. 3) is provided on a concentric circle for assisting the user in moving his/her fingers in rotary motion. On the front surface, the images such as thumbnail images and icons are laid out and displayed (701, Fig. 7). Hisatomi shows or suggests no image of the rib on the front surface. In Hisatomi, the rib is simply for finger movement and is not displayed on the front surface. Although the front surface may indicate thumbnail images and icons, these images do not have substantially the same geometrical shape as the rib. See Fig. 7 wherein the ribs having a width are provided on concentric circles on the rear surface, but the front surface shows no image having such a width or such concentric circles.

In contrast, in Claim 1, an image representing the touch-operation guide shape formed with the ribs is displayed on a display device, wherein the image has substantially the same geometrical shape (including the width of the ribs) as the touch-operation guide shape formed with the ribs. Clearly, Hisatomi does not teach or suggest displaying an image having substantially the same geometrical shape as the touch-operation guide shape.

Further, in Claim 1, the operation function items are superposed on the image (e.g., Fig. 4 in comparison with Fig. 2). As is clear from Figs. 4-8 of Hisatomi, no image of ribs are superposed on the thumbnail images or icons. In Hisatomi, the ribs are simply for finger movement in rotary motion and thus provided on concentric circles, and therefore, there is absolutely no need for Hisatomi to superpose an image of ribs on the thumbnail images or icons. There is no motivation in Hisatomi to superpose an image of ribs on thumbnail images or icons.

That is, Hisatomi does not teach or even suggest the claimed "control means" for controlling the display device to display an image representing the touch-operation guide shape formed with the ribs, which image has substantially the same geometrical shape as the touch-operation guide shape formed with the ribs in such a way that the operation function items are superposed on the image.

Additionally, Hisatomi does not teach any method or technology which enables superposing the function items on the images. Hisatomi's teachings are technologically too primitive (which are simply the front side and reverse side operation). Neither Yoshimasa nor Hisatomi teaches or suggests the claimed "control means".

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“To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” (M.P.E.P. § 2143.03) (Emphasis added.) “[O]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hospital Systems, Inc. v. Montefiore*, 732 F.2d 1572, 1577 (Fed. Cir. 1984) (Emphasis added.)

The Examiner fails to show all the claim limitations and further fails to show some teaching or suggestion supporting a combination.

Thus, the teaching of Yoshimasa et al. and Hisatomi et al. could not render Claim 1 obvious. Accordingly, Claims 1 as well as the dependent claims could not obvious over the references. It is respectfully requested that the rejection be withdrawn.

Allowable Subject Matter

Claims 3-9, 12-14, 20, and 21 have been allowed. Claim 10 has been objected to, but would be allowable if appropriately rewritten. Claim 10 is dependent ultimately on Claim 1, and at least for the reason, Claim 10 should be allowable as it is.

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CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.


Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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